



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of

Jonathan ADAMS et al.

Serial No. 10/825,184

Filed: April 16, 2004

For: IMPROVED DESIGN FOR LACROSSE STICK AND METHOD OF USING

SAME

Atty. Ref.: 1444-2

TC/A.U.: 3711

Examiner: Michael S. Chambers

April 12, 2007

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Applicants submit herewith their Brief on Appeal pursuant to 37
CFR §41.37.

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(I) REAL PARTY IN INTEREST

The real parties in interest are the inventors, Jonathan R. Adams and Robert W. Adams.

(II) RELATED APPEALS AND INTERFERENCES

On information and belief, there are no prior or pending appeals, interferences, or judicial proceedings (past or present), known to appellants or the appellants' legal representative, which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in this appeal.

(III) STATUS OF CLAIMS

Claims 1-2 and 10-11 are pending.

Claims 1-2 stand rejected under Section 102(b) as anticipated by Dill (USP 5935026); and claims 10-11 stand rejected under Section 103 as obvious over Dill.

The rejections of claims 1-2 and 10-11 are being appealed. A listing of claims is presented in the Claims Appendix to this Appeal Brief.

(IV) STATUS OF AMENDMENTS

An Amendment After Final Rejection was submitted on September 13, 2006. This amendment submitted only arguments for reconsideration and it did not make any amendments to the pending claims. In an Advisory Action dated September 27, 2006, the Examiner maintained the rejections.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

This application generally describes by way of example without limitation a method of playing lacrosse wherein one or more lacrosse players is capable of intentionally adjusting the length of his/her lacrosse stick during a lacrosse game and without leaving the lacrosse field. Some other example embodiments in the application generally disclose a method of playing lacrosse where the adjustments are non-destructive and/or are made one or more times during a game. In further embodiments, the adjustments are made during the game while playing lacrosse without the use of separate tools.

The disclosed embodiments provide a variety of advantages over the use prior art lacrosse sticks. For example, lacrosse players frequently have a number of sticks of different lengths. Thus, if a player is on defense, he/she may want a "long pole" but, if shifted to attack, the player will want a shorter attack stick.

Likewise, when playing middie, the player may want to use a "long pole" sometimes and a shorter pole at other times. To play lacrosse, such a player would need multiple lacrosse sticks, which are fairly expensive.

In addition, lacrosse sticks are sold in standard lengths. Often, players will "adjust" the length of the stick by cutting the sticks to a shorter length. However, such an adjustment is destructive; it does not take place on a playing field; and the stick is not capable of being adjusted one or more times during a game.

The general nature of the adjustable lacrosse stick is shown in Figures 1-5. Figures 1-2 show how the length can be adjusted relative to the size of a lacrosse player.

Figures 3-4 illustrate an exemplary means for adjusting the length of the stick. This example employs a combination of depressible knobs 118 and holes/slots 120 on shaft 114 that contains two or more telescoping shaft sections.

The disclosed example methods provide, among other things, a method of playing lacrosse where the length of the lacrosse stick can be adjusted during a game "on the fly." For example, the adjustment can be made without leaving the playing field and/or without the use of any separate tools.

A method of playing lacrosse in accordance with one non-limiting, illustrative example embodiment as reflected in claim 1 involves one or more lacrosse players intentionally adjusting the length of their lacrosse stick during a lacrosse game without leaving the lacrosse playing field. See, e.g., paragraphs [0001]; [0007]; [0025]; and [0026].

A method of playing lacrosse in accordance with another non-limiting example embodiment as reflected in claim 2 involves one or more lacrosse players intentionally adjusting the length of their lacrosse stick without using any separate tools. See, e.g., paragraphs [0001]; [0007]; [0025]; and [0026].

A method playing lacrosse in accordance with another non-limiting example embodiment as reflected in claim 10 involves using a lacrosse stick to play a lacrosse game on a lacrosse playing field. See, e.g., paragraphs [0001]; [0007]; [0025]; and [0026]. The lacrosse stick includes a shaft and a head, the head being coupled to one end of the shaft and adapted to receive a lacrosse ball. See, e.g., Figures 1-5; paragraphs [0015]; [0021]; and [0024]. The length of shaft of the lacrosse stick can be non-destructively adjusted one or more times during

the game without leaving the lacrosse playing field. See, e.g., paragraphs [0001]; [0007]; [0025]; and [0026].

A method playing lacrosse in accordance with another non-limiting example embodiment as reflected in claim 11 involves using a lacrosse stick to play a lacrosse game on a lacrosse playing field. See, e.g., paragraphs [0001]; [0007]; [0025]; and [0026]. The lacrosse stick includes a shaft and a head, the head being coupled to one end of the shaft and adapted to receive a lacrosse ball. See, e.g., Figures 1-5; paragraphs [0015]; [0021]; and [0024]. The length of shaft of the lacrosse stick can be non-destructively adjusted one or more times during the game without using any separate tools. See, e.g., paragraphs [0001]; [0007]; [0025]; and [0026].

(V) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-2 were rejected under 35 U.S.C. Section 102(b) as allegedly being anticipated by Dill (U.S. Patent No. 5,935,026).

Claims 10-11 were rejected under 35 U.S.C. Section 103 as allegedly being made obvious by Dill.

(VI) ARGUMENT

Claim 1 is patentable because it is not anticipated by Dill. Claim 1 describes a method of playing lacrosse wherein one or more players can intentionally adjust the length of their lacrosse stick "during a lacrosse game without leaving the lacrosse playing field."

The Examiner cites to Figure 4 of the Dill patent in support of the Section 102(b) rejection. However, Dill does not disclose adjusting the length of a lacrosse stick during a game and without leaving the playing field.

Instead, Dill teaches that the lacrosse stick must be broken apart (*i.e.*, a destructive action leaving the stick inoperable and the player out of action) and then a new shaft piece is inserted (or removed from) between the shaft and the head. Any lacrosse player would immediately know that the Dill concept is not to be performed on the playing field during a game.

Consequently, a person skilled in the art would recognize that the teaching of Dill does not show adjusting the length of a lacrosse stick "during a lacrosse game without leaving the lacrosse playing field." Therefore, Dill cannot anticipate claim 1. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Claim 2 describes a "method of playing lacrosse" wherein one or more players can intentionally adjust "the length of their lacrosse stick without using any separate tools."

The Examiner rejects claim 2 on the same Section 102 (b) basis as claim 1. However, Dill does not disclose adjusting the length of a lacrosse stick (a) while playing lacrosse or (b) without using any separate tools.

Rather, the Dill adjustment to the stick is not intended to be performed while playing lacrosse. A person skilled in the art would know that the Dill invention is performed outside of the playing field and, therefore, it is not a "method of playing lacrosse."

The Examiner fails to cite any teaching to this effect in the Dill patent. Thus, because claim 2 relates to a "method of playing lacrosse," this omission from the Dill patent establishes that the reference cannot anticipate claim 2.

In addition, the Dill patent requires the use of separate tools (*e.g.*, a screwdriver) to strongly affix the rear end via a fixation means 605. While the patent merely mentions a "plug" (col. 5, line 3), a person skilled in the art would know that a plug alone will not keep the lacrosse stick in one piece when playing lacrosse because the stick could fly apart into separate pieces during vigorous play. Instead, a screw or other fixation means is needed.

Consequently, a person skilled in the art reading Dill would not normally think that it teaches an adjustment of "the length of a lacrosse stick without using any separate tools." Therefore, Dill does not anticipate claim 2.

Claim 10 describes a "method of playing lacrosse" wherein one or more players can adjust the length of their lacrosse stick "during a lacrosse game without leaving the lacrosse playing field." In addition,

claim 10 describes a method involving “non-destructively adjusting the length of the shaft” of a lacrosse stick.

However, Dill does not disclose or suggest adjusting the length of a lacrosse stick during a game and without leaving the playing field. In addition, Dill does not teach or suggest the non-destructive adjustment of the length of the shaft of a lacrosse stick while playing lacrosse.

Instead, Dill teaches that the lacrosse stick must be broken apart (*i.e.*, a destructive action leaving the stick inoperable and the player out of action) and then a new shaft piece is inserted (or removed from) between the shaft and the head. Consequently, a person skilled in the art would recognize that the teaching of Dill does not show or suggest adjusting the length of a lacrosse stick “during the game without leaving the lacrosse playing field.”

In addition, such a person would recognize that Dill does not show or suggest a non-destructive adjustment to the stick while “playing lacrosse.”

Therefore, Dill fails to render obvious the invention set forth in claim 10 for at least two reasons.

Finally, Claim 11 describes a “method of playing lacrosse” wherein one or more players can adjust the length of their lacrosse stick “during a lacrosse game without using any separate tools.” In addition, claim 11 describes a method involving “non-destructively adjusting the length of the shaft” of a lacrosse stick.

As discussed above, Dill does not disclose or suggest adjusting the length of a lacrosse stick while playing lacrosse and without using any

separate tools. In addition, Dill does not teach or suggest the non-destructive adjustment of the length of the shaft of a lacrosse stick while playing lacrosse.

Once again, Dill teaches that the lacrosse stick must be broken apart (*i.e.*, a destructive action leaving the stick inoperable and the player out of action) and then a new shaft piece is inserted (or removed from) between the shaft and the head via the use of separate tools. Consequently, a person skilled in the art would view Dill as failing to show or suggest the adjustment while "playing lacrosse" of the length of a lacrosse stick "during a lacrosse game without using any separate tools."

In addition, such a person would not recognize the teaching of Dill as showing or suggesting a non-destructive adjustment. Rather, Dill's invention involves the destructive act of breaking the stick apart and making it inoperable during the adjustment period.

Therefore, Dill neither anticipates nor renders obvious claim 11 for, at least, these two reasons.

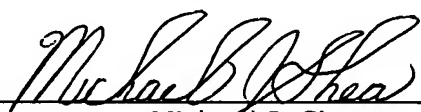
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CONCLUSION

For all the reasons advanced above, reversal of the Examiner's
Rejections and allowance of pending claims 1-2 and 10-11 is solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
Michael J. Shea
Reg. No. 34,725

MJS:mjs
901 North Glebe Road, 11th Floor
Arlington, VA 22202-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

(VII) CLAIMS APPENDIX

Claim 1 (Previously Presented): A method of playing lacrosse, wherein one or more lacrosse players is capable of intentionally adjusting the length of their lacrosse stick during a lacrosse game without leaving the lacrosse playing field.

Claim 2 (Previously Presented): A method of playing lacrosse, wherein one or more lacrosse players is capable of intentionally adjusting the length of their lacrosse stick without using any separate tools.

Claims 3-9 (Canceled).

Claim 10 (Previously Presented): A method of playing lacrosse comprising:
using a lacrosse stick to play a lacrosse game on a lacrosse playing field, the lacrosse stick comprising a shaft and a head, the head being coupled to one end of the shaft and adapted to receive a lacrosse ball; and
non-destructively adjusting the length of the shaft of the lacrosse stick one or more times during the game without leaving the lacrosse playing field.

Claim 11 (Previously Presented): A method of playing lacrosse comprising:
using a lacrosse stick to play a lacrosse game on a lacrosse playing field, the
lacrosse stick comprising a shaft and a head, the head being coupled to one end of the
shaft and adapted to receive a lacrosse ball; and
non-destructively adjusting the length of the lacrosse stick one or more times
during the game without using any separate tools.

(VIII) EVIDENCE APPENDIX

No evidence has been submitted during the prosecution of this application pursuant to §§1.130, 1.131, 1.132.

(IX) RELATED PROCEEDINGS APPENDIX

(None)